

Remarks

Claims 1-20 are pending in the above-identified application. Claims 1, 8, and 15 are amended, claims 10 and 13 are cancelled, and claims 2-7, 9, 11, 12, 14 and 16-20 are original.

The Examiner rejected claims 10 and 13 under 35 U.S.C. 112. With this amendment Applicant has cancelled claims 10 and 13.

The Examiner rejected claims 1, 3-8, 10-15, and 17-20 under 35 U.S.C. 102(e) as being anticipated by Hotti (U.S. PGPub 2003/0236874).

The following legal requirement is quoted from MPEP 2131 and establishes what is required to sustain a rejection under 35 U.S.C. §102. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

It is well-settled that there is no anticipation unless (1) all the same elements are (2) found in exactly the same situation and (3) are united in the same way to (4) perform the identical function. Since the Office Action's citations to each of the applied references is missing at least one element of each of Applicants' independent claims, Applicants respectfully submit that the claimed invention is not anticipated by the Office Action's citations to the applied references, as further discussed below.

Hotti discloses: "The invention is in the area of scalable real time service usage monitoring and billing for wireless smart network infrastructures such as 3G networks. The invention relates to a method and an arrangement for collecting large amounts of service usage data from large number of sources for large number of subscribers. This data can be used for

example for real time Quality of Service monitoring and usage-based service billing purposes. Especially the invention relates to a method and an arrangement for network data management, where at least one personal dedicated database is arranged for a user and where service usage information of said user is managed by said personal master database. Further, the invention addresses the problem of matching the usage monitoring data with the subscriber profiles."

The independent claims have been changed to more clearly define the present invention by inclusion of the following features in independent claim 1: changing, directly via the mobile station, the mobile configuration data in the network subscriber database; and synchronizing, in response to the changing of the mobile configuration data in the network subscriber database, the mobile configuration data in the mobile subscriber database with the mobile configuration data in the network subscriber database of the mobile station, such that the changed mobile configuration data is first updated in the network subscriber database and then downloaded to the mobile station where the changes are applied to the mobile configuration data in the mobile subscriber database of the mobile station. This embodiment of the present invention may be considered to have three successive phases; first, changing, directly via the mobile station, the mobile configuration data in the network subscriber database, second, the changed mobile configuration data is updated in the network subscriber database, and, third, downloading the changed mobile configuration data to the mobile station. The independent claims 8 and 15 have been similarly amended.

Hotti teaches the following:

In paragraph 66: "The collected data and user's profile data is stored to the user's master database. . . The other parties or elements in the data network may typically be replica databases

of database servers of usage record collectors relating to the services subscribed or used by the user. The elements may comprise at least one replica database corresponding at least partly the user's master database."

In paragraph 71: "The master databases 302, 304, 306 of subscribers typically contain all the information that is relevant to the subscriber."

In paragraph 72: "The replica databases 302a, 304a, 306a may contain a copy of some or all of this information, such as for example subscriber preferences and service rating specific to the subscriber and this service."

However, Hotti does not disclose or suggest each of the claimed elements of the independent claims as described above. In particular, for example, Hotti does not disclose each of: changing, directly via the mobile station, the mobile configuration data in the network subscriber database; updating the changed mobile configuration data in the network subscriber database; and downloading the changed mobile configuration data to the mobile station.

The Examiner rejected claims 2, 9, and 16 under 35 U.S.C. 103(a) as being unpatentable over Hotti (U.S. PGPub 2003/0236874) and Liljestrand et al. (U.S. Patent 6,853,714).

MPEP §706.02(j) states:

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable

expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

MPEP §2143.01 provides: The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

One court further noted that there were three possible sources for such motivation, namely "(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art." Id. at 1357, 47 USPQ2d at 1458. Here, according to this court, the Board had relied simply upon "the high level of skill in the art to provide the necessary motivation," without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Prima facie obviousness only exist when the prior art suggests or anticipates the benefits of modifying or combining references or when external factors, such as the changing state of the art, provide the motivation to one of ordinary skill in the art to make the modification or combination. However, where no reasonable

intrinsic or extrinsic justification exists for the proposed combination or modification, prima facie obviousness will not have been established.

The black letter law statements by Judge Linn in *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000) are applicable to the present rejections, viz:

a) Hindsight Syndrome

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then accepted wisdom in the field. ... Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." (Id. at 1369, 55 USPQ2d at 1316) (citations omitted).

b) Need for Motivation

Most if not all inventions arise from a combination of old elements. ... Thus, every element of a claimed invention may often be found in the prior art. *See Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. (Id. at 1369, 55 USPQ2d at 1316) (citations omitted).

c) Particular Findings Required

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. ... The test for

an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. ... Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto. Broad conclusionary statements standing alone are not "evidence." (Id. at 1370, 55 USPQ2d 1317) (citations omitted).

Liljestrand et al. discloses: "An apparatus and method is disclosed for providing transparent enhanced telecommunications services to subscribers by implementing an enhanced services platform on a local network exchange within the public telephone network. More specifically, the apparatus and method of the present invention is capable of providing a plurality of enhanced telecommunications services to a subscriber by using a voice-activated interface to enable the subscriber to access at least one of the plurality of enhanced telecommunications services. In addition, the apparatus and method of the present invention may use a web-activated interface to enable the subscriber to access at least one of the plurality of enhanced telecommunications services."

The Examiner cited Liljestrand et al. for disclosing a method of providing enhanced telecommunication services to subscribers by enabling a voice system and web-based graphical user interface for subscriber. Claims 2, 9, and 16 are dependent claims. The dependent claims include all the limitations of the respective independent claims upon which they depend, and are therefore also allowable over the cited prior art for the reasons set forth above with respect to independent claims.

Reconsideration and withdrawal of the rejections is therefore respectfully requested. In view of the above remarks, allowance of all claims pending is respectfully requested.

The prior art made of record and not relied upon is considered to be of general interest only. This application is believed to be in condition for allowance, and such action at an early date is earnestly solicited. If a telephone conference would be of assistance in advancing the prosecution of this application, the Examiner is invited to call applicant's attorney.

Respectfully submitted,



John R. Garrett
Attorney for Applicant
Reg. No. 27,888

Dated: October 11, 2007

PATTI, HEWTTI & AREZINA LLC
Customer Number 47382